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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,893	08/24/2001	Robert Seseck	10010609-1	2504
7590	01/30/2006		EXAMINER	
HEWLETT-PACKARD COMPANY			SAFAIPOUR, HOUSHANG	
Intellectual Property Administration			ART UNIT	PAPER NUMBER
P.O. Box 272400				
Fort Collins, CO 80527-2400			2627	

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/938,893	SESEK ET AL.	
	Examiner Houshang Safaipour	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 November 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,7-13,15-21,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,7-10,13,15-18,21,26 and 27 is/are rejected.
- 7) Claim(s) 11,12,19 and 20 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's amendment filed on November 7, 2005 has been entered and made of record.

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The underlined portion of the following limitation of claim 1 is vague and indefinite:

"a scan window illumination device including a plurality of light sources with individual of the plurality of moveable position markers including a one of the plurality of the light sources and with the plurality of the light sources configured to direct light into the first side and the second side.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7-10, 13, 15, 16-18, 21, 26, 27 are rejected under 35 U.S.C. 102(b) as being unpatentable over Kurata et al. (U.S. Patent No. 4,518,999).

Regarding claim 1, Kurata et al. discloses a scan window apparatus for indicating a scan window within a member of a scanning device, the member having a first side and a second side intersecting the first side (fig. 1) comprising:

a scan window definition device including a plurality of moveable position markers (cursors 3, 4, 5 and 6) configured to move along the first side and the second side of the member (fig. 1, col. 1, lines 30-41); and

Kurata discloses that the cursors (position markers) 3, 4, 5 and 6 are used in a conventional picture image position setting apparatus in which a desired region of an original document can be **directly designated on a platen** (col. 1, lines 23-25). Kurata uses cursors, in different configuration, in his “Picture Image Position setting Apparatus” for designating desired region of an original on the platen. Kurata further discloses that a light emitting element such as a light emission diode may be provided at the cursors. Therefore it would have been obvious to a person of an ordinary skill in the art to provide light emission diode at cursors 3, 4, 5 and 6 of a conventional position setting apparatus to identify a desired region (scanning window) on platen 2 as shown on figure 1.

Regarding claim 2, Kurata discloses the scan window apparatus of claim 1, and wherein the member comprises an essentially transparent platen defined by a first surface on which an object to be scanned can be placed, and an opposite second surface (fig. 1).

Regarding claim 7, Kurata discloses the scan window apparatus of claim 1, wherein: the member includes a transparent platen having a top surface and a bottom surface; and

the plurality of the light sources are located proximate to the first side and the second side to allow the light to enter the platen between the top surface and the bottom surfaces (fig. 1 and please refer to the detailed explanation under claim 1).

Regarding claims 8, 9, 13, 15, 16-18, 21, and 27, arguments analogous to those presented for claim 1 are applicable to claims 8, 9, 13, 15, 16-18, 21 and 27.

Regarding claims 10, Kurata discloses the scan window apparatus of claim 9, wherein the scan window definition device comprises a plurality of moveable position markers configured to move along the first edge and the second edge of the scanable surface and thereby define the scan window, the scan window apparatus further comprising a plurality of position detectors configured to detect the positions of the plurality of position markers along the first and second edges of the scanable surface and to generate position signals in response thereto, and wherein the apparatus is configured to use at least one of the position signals to direct the focused beam of light (fig. 1, col. 1, lines 42-51 and also the discussion under claim 1).

Regarding claim 26, arguments analogous to those presented for claim 10 are applicable to claim 26.

***Allowable Subject Matter***

Claims 11, 12, 19, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipour whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Thurs. from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles, Sr. can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Houshang Safaipour  
Patent Examiner  
Art Unit 2622  
January 20, 2006



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